

fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable."

Further, as is stated in MPEP 707.07

"Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim **on all valid grounds available**, avoiding, however, undue multiplication of references." (emphasis added).

MPEP 706.07 requires that a clear issue should be developed between the Examiner and the Applicant before a Final Rejections is in order. This section of the MPEP further states:

"To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by the applicant and the public, the invention **as disclosed and claimed** should be **thoroughly searched in the first action and the references fully applied**; ... Switching from one subject matter to another in the claims presented by applicant in successive amendment, or from one set of references to another by the examiner in rejection in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection. ... **The applicant who is seeking to define his or her invention** in the claims that will give him or her the patent protection to which he or she is justly entitled **should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application**.... The examiner should never lose sight of the fact that in **every case** the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal. However, it is to the interest of the applicants as a class as well as to that of the public that prosecution of an application be confined to as few actions as is consistent with a thorough consideration of its merits." (emphasis added).

MPEP 706.07(a) states

"A second or any subsequent action on the merits in any application ... **should not be made final if it includes a rejection**,

on prior art not of record, **of any claim amended to include limitations which should reasonably have been expected to be claimed.** See MPEP 904 et seq." (emphasis added)

MPEP 904 states

"The Examiner, after having obtained a thorough understanding of the invention disclosed and claimed in the nonprovisional application, the searches the prior art as disclosed in patents and other published documents. i.e., nonpatent literature (NPL). ... **In all continuing applications, the parent application should be reviewed by the Examiner for pertinent prior art.** ..." (emphasis added).

In the present application, Applicants are of the opinion that the Final Rejection of December 31, 2002 is premature for one or more of the following reasons:

Reason 1. Applicants submit that if the Examiner is of the opinion that Chien et al., U.S. Pat. No. 5,558,924, is proper to reject the claims of the application, as the claims are now amended, this reference should have been applied in the first Office Action. The only arguably substantive change made to the claims in the Amendment filed on October 17, 2002 was that claim 13 amended to require that the web to be unbonded prior to corrugation. However, it is also pointed out that this amendment to claim 13 should be construed as clarifying features of the claims, since claim 13 required corrugating, then bonding the web. Although not specifically stated, claim 13 before the amendment implied that the web was unbonded before corrugation. The original claim could have, and should have been construed that the web was unbonded prior to corrugation and bonding. The other changes to the claims merely clarified the claims and were not substantive. Therefore, Chien et al. should have been applied against the claims in the First Office Action. MPEP 707.07 requires that all valid grounds available for rejecting the claims should be made in an Office Action. Further MPEP 706.07 requires that the invention be thoroughly searched and the reference fully applied in the first Office Action before a Final Rejection is made. The Examiner did not include Chien et al. in the grounds of the rejection, but merely made a statement in the first Office Action "Chien et al (5558924) teaches elements of applicant's claims". Such a statement misleads and suggests to the Applicants that Chien et al. teaches some, but not all, elements of the Applicants' claims. How can a reference not be prior art against

a broad claim, but becomes prior art when a claim is arguably narrowed? The answer is, it cannot.

Reason 2. The present application is a divisional application of SN 09/212,797 filed on December 16, 1998. As required by MPEP 904, the Examiner should have considered the parent application before issuing an Office Action on the above-identified application. Having considered this application, the Examiner would have seen that similar amendments were made in the parent application, and the Examiner should have expected that similar amendments would be made in the divisional application. Actually, the Examiner changed the rejection in the parent application in the same manner as he has done in the above-identified application, which further suggests that the Examiner knew that the Chien et al. reference could be applied as prior art against the claims. MPEP 706.07 states that a second action should not be made final if any claim is amended to include limitations the Examiner should have reasonably expected to be made. In this case, the fact that the Examiner reviewed, or should have reviewed the parent application as required by MPEP 904, the Examiner should have expected that the claims would be amended to recite that the web is unbonded, corrugated and then bonded. MPEP 706.07(a) does not allow for a second action Final Rejection over unrelied upon prior art, when the Examiner should have reasonable expected certain amendments to be made to the claims.

Reason 3. As is stated in MPEP 706.07, the Applicant should receive the cooperation of the Examiner when the claims are amended to define the invention and the Examiner should not prematurely cut off prosecution. In addition, MPEP 706.07 holds that the Applicants are entitled to a "full and fair hearing". In the present application, the issuing of the Final Rejection on the second Action cuts off the prosecution of the application prematurely, especially in light of reasons 1 and 2 stated above. Applicants have not been given a full and fair hearing to allow clear issues to be developed before appeal. The tactic of the Examiner, considering that Chien et al. did not rise to the level of a rejection in the first Office Action, but upon reconsidering Chien et al. after the claims were narrowed or clarified, the Examiner finds that the reference rises to the level of a rejection in the second Office Action, is unfair to the Applicants and does not allow clear issues to be developed before the Final Rejection was issued.

For each of the three reasons above, individually or collectively, Applicants are of the opinion that the Final Rejection of December 31, 2002 is premature and should be withdrawn. Applicants respectfully request that the Examiner withdraw the finality of the Office Action mailed December 31, 2002.

**Response to Rejections under 35 U.S.C. § 103(a)**

Claims 13, 14, 17, 18, 20, 22, 23 and 24 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over U.S. Pat. No. 5,558,924 to Chien et al. Applicants respectfully traverse this rejection.

Before addressing this rejection, Applicants believe it would be beneficial to describe the claimed invention.

Applicants' claims are directed to a laminate comprising a first layer and a second layer. The first layer comprises a corrugated nonwoven web having a surface with a surface area and at least 40 percent of said surface area is made from fusible fibers. In producing the corrugated layer, the nonwoven web, in its unbonded state, is corrugated to produce folds and subsequently bonded throughout. The corrugated layer is required by claim 13 to be folded in a fashion such that there are no gaps are present between the individual folds. The second layer may be a nonwoven web, woven web, a knit web, a film, atissue, paper, a foil or a foam.

Turning to the rejection, the Examiner correctly notes that Chien et al. teaches a corrugated nonwoven web, and that the nonwoven web is unbonded when corrugated, and then bonded. The Examiner incorrectly notes; however, that the corrugated nonwoven web of Chien et al. lacks gaps between the folds. To support that Chien et al. does not teach gaps between the folds, the Examiner relies upon column 3 and Figures 9 and 11 of Chien et al.

Applicants have carefully reviewed column 3 of Chien et al. and are unable to find where Chien et al. state, teach or suggest that there are no gaps between the folds. However, Applicants were able to locate in column 4, lines 6-13, that gaps or spaces exists between the corrugations, as is shown in Figure 5 of Chien et al. Further, Figures 6 and 7 show gaps between the folds or corrugations. Therefore, it is rather clear that Chien et al. wants spaces between the folds.

To further support his position, the Examiner finds that Figures 9 and 11 show that there are no gaps between the folds or corrugations. Applicants point out that Figures 9 and 11 are concerned with the brushing aspect of the invention and the results of the brushing. This set of Figures does not show the entire web and only shows the surface of the web. In fact, Figures 9 and 11 are actually magnifications of the web to show the process of brushing and the resulting effects at an individual fiber scale. In considering Figures 9 and 11, one must also consider Figure 10, which shows the results of brushing on the web, from a view of the full web, not a view on an individual fiber scale. Therefore, Figures 9 and 11 do not support the Examiner's contention that Chien et al. teach or suggest preparing.

The Examiner also finds that using the Applicant's claimed percentage of fusible fibers is obvious and only a matter of routine skill in the art to optimize, motivated by the desire to obtain suitable bond strength to improve the tear resistance. There is no suggestion in Chien et al. which teaches one skilled in the art that at least 40% of the surface of the web should be fusible fibers. As is stated in the specification at page 17, lines 14-16, at least 40% of the fibers need to be fusible to result in a corrugated web with sufficient mechanical compression resistance. Further, the Examples in the specification show that corrugated webs having less than 40% fusible fibers have poorer compressive toughness as compared to the webs having more than 40% of the surface comprised of fusible fibers. In addition, the Examiner has not shown that it is known in the art of corrugated nonwoven webs to use more than 40% fusible fibers on the surface of the web. Chien et al. only make a suggestion that the web may contain fusible fibers, but does not provide any direction to those skilled in the art to use at least enough fusible fibers, so that the surface of the corrugated nonwoven web is at least 40% fusible fibers. In addition, Applicants are the ones who have made the contribution to the art recognizing that at least 40% of the surface of the corrugated nonwoven web should be fusible fibers, to obtain compressive toughness. Hence, the claim limitation requiring that the corrugated nonwoven web have at least 40% fusible fibers at the surface of the web is not taught in the prior art.

Finally, the Examiner states that the claimed configurations of the present claims are shown in Figures 5 and 6. Applicants disagree. The configurations shown in Figures 5 and 6 have spaces between the corrugations. Clearly, the claims of the

present application do not allow for spaces or gaps between the folds. Therefore, the Examiner's statement is clearly incorrect.

In view of the forgoing remarks, it is respectfully submitted that the rejection of the claims based only on Chien et al. is untenable and should be withdrawn.

Claims 15, 16, 19, 21 and 25-29 were rejected under 35 U.S.C. § 103 as allegedly being obvious to one of ordinary skill in the art at the time the invention was made and thus unpatentable over U.S. Pat. No. 5,558,924 to Chien et al. in view of U.S. Patent Number 5,906,879 to Huntoon et al. This rejection is respectfully **traversed**.

In the statement of this rejection, the Examiner only relies upon Huntoon et al. to teach that corrugated webs may be prepared from superabsorbent fibers and that corrugated webs may have folds of differing heights. The Examiner correctly acknowledges that Chien et al. does not teach these claim limitations.

Even if one skilled in the art were to combine the teachings of Huntoon et al. with Chien et al. as suggested by the Examiner, one skilled in the art would not arrive at the claimed invention. Specifically, the Examiner does not address how the deficiencies of Chien et al. noted above are remedied by Huntoon et al. The Examiner does not suggest how Huntoon et al. cures the requirement in the claims that at least 40% of the fibers are fusible fibers, or how Huntoon et al. suggest that the web Chien et al. Therefore, Huntoon et al. does not cure the noted deficiencies of Chien et al.

It is further noted that Huntoon et al. is directed toward providing space between the corrugations into which fluids or feces may be deposited. The space provided is a gap between each of the folds of the corrugated material (see column 6, lines 27-33 and column 6, line 65-column 7, line 4). One skilled in the art reading Huntoon et al. would be motivated to have gaps between the folds, especially in personal care products, in view of Huntoon's clear teaching which requires gaps between the folds. Therefore, combining the teachings of Huntoon et al. with Chien et al. only serves to reinforce the teachings of Chien et al. to provide spaces between the corrugations.

In order for a combination of references to render a claim obvious under the meaning of 35 USC 103, the invention as a whole, including all of the limitations of the claims, must be taught or suggested by the references. In the present rejection, the claim limitations of bonding the web throughout after corrugation, using at least 40%

fusible fibers are not taught and having no gaps between the folds is not taught by Chien et al. and Huntoon et al., and the Examiner has not clearly stated how these limitations are suggested by Chien et al. and Huntoon et al. Therefore, the rejection of the claims based on the combination of Chien et al. and Huntoon et al. is untenable, and should be withdrawn.

Please charge any prosecutorial fees which are due to Kimberly-Clark Worldwide, Inc. deposit account number 11-0875.

The undersigned may be reached at: 770-587-7204.

Respectfully submitted,

Margaret Gwyn Latimer ET AL.

By: 

Ralph H. Dean, Jr.

Registration No.: 41,550

Attorney for Applicants

#### CERTIFICATE OF MAILING

I, Ralph H. Dean, Jr., hereby certify that on March 14, 2003 this document is being deposited with the United States Postal Service as first-class mail, postage prepaid, in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231.

By: 

Ralph H. Dean, Jr.